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REMARKS

The Examiner has refused to consider the merits of the information referred to in the information disclosure statement filed 2/15/05 for failing to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP 609 because the references are not listed on a 1449 form. To comply with such provisions, applicant has submitted a new information disclosure statement listed on a 1449 form, on April 13, 2005.

The Examiner has rejected Claim 42 under 35 USC 112, first paragraph as providing new matter not originally described in the specification. Specifically, the Examiner has stated '[n]o where in the Specification does the applicant describe that it is determined whether the storage is disabled "only after" determining whether the scanning module is disabled.' Applicant respectfully disagrees with such rejection in view of the clear support for such claim language in Figure 8 of applicant's originally-filed application, as shown below:

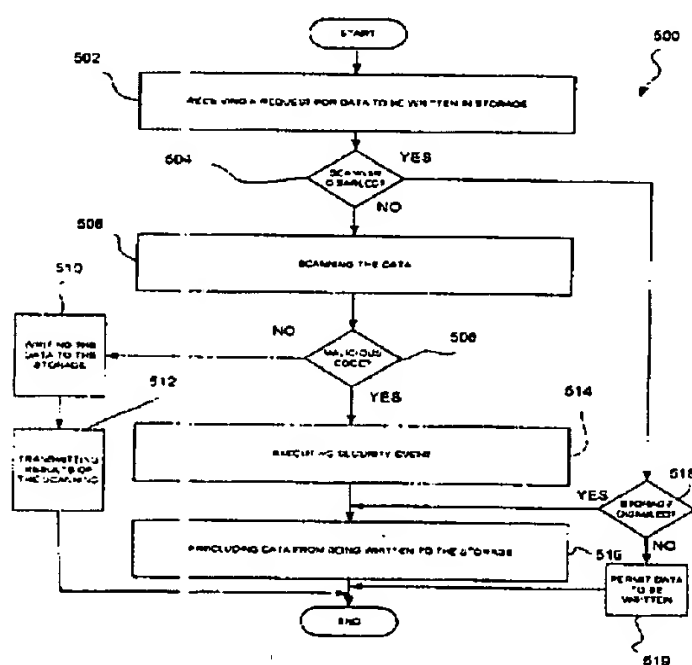


Figure 8

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Applicant points out step 504 of Figure 8, wherein it is first determined whether the scanner is disabled. Next, and only if the scanner has been disabled, as depicted by the Yes arrow from 504, is it next determined if the storage is disabled (operation 518). Thus, operation 518 occurs, as shown, only after operation 504 (and not after any other operations shown). To this end, applicant's claimed "wherein it is determined whether the storage is disabled only after determining whether the scanning module is disabled" (see Claim 42) is fully supported by the specification with regard to Figure 8.

It is noted that the Examiner has rejected Claim 43 as being dependent on Claim 42. In view of the remarks made hereinabove, a notice of allowance or a specific prior art showing of all of such claim limitations, in combination with the remaining claim elements, is respectfully requested.

The Examiner has again rejected Claims 1-40 under 35 USC 103(a) as being unpatentable over Makita (U.S. Patent No. 2001/0007120) in view of Flint (U.S. Patent No. 6,735,700). Applicant respectfully disagrees with such rejection.

With respect to independent Claims 1 and 17, the Examiner relies on the following excerpt from Flint to meet applicant's claimed "wherein a user is allowed to disable the scanning module, and data is precluded from being transmitted from the storage to the central processing unit upon the disabling of the scanning module":

"The third activity waits for user input (block 421). When user input is received, it is evaluated to determine if the user has requested that a particular file be scanned (block 423). If so, an on-demand scan is performed using the requested file as the scan set as described below with reference to FIG. 6. If the user input specifies the termination of the anti-virus program (block 427), a termination process illustrated by block 429 and described in more detail below in conjunction with FIG. 8 is performed. When the user has previously requested the scanning facility be stopped (as described next), the user can request it be restarted (block 431). Any other user input, including a request to stop the scanning facility, is processed at block 433. Such user input also includes changing preference parameters that control the overall functioning of the anti-virus software. The user can also specify which files to include in a pre-defined scan set that is used by the on-demand scan of FIG. 6. The handling of such user input is well understood in the art and is

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not discussed further. Moreover, it will be appreciated that the input interface is conventional and thus not illustrated." (Col. 9, lines 5-24 - emphasis added)

Applicant respectfully asserts that the above excerpt from Flint simply discloses "[i]f the user input specifies the termination of the anti-virus program (block 427), a termination process illustrated by block 429 and described in more detail below in conjunction with FIG. 8 is performed". Thus, Flint only teaches a user terminating the anti-virus program, and not "data is precluded from being transmitted from the storage to the central processing unit upon the disabling of the scanning module," as claimed by applicant.

To further clarify this distinction, applicant respectfully points out Fig. 8 in Flint, as referred to in the above excerpt. Specifically, Fig. 8 teaches writing to permanent storage (block 803) even after a user has specified to terminate the anti-virus program (block 429 of Fig. 4). Applicant respectfully asserts that this clearly *teaches away* from applicant's claim language since applicant specifically claims "data is precluded from being transmitted from the storage to the central processing unit upon the disabling of the scanning module" (emphasis added). Allowing the data to be written to storage or read from storage without fully completing a scan, as in Flint, would provide the opportunity for malicious code to execute and/or proliferate on the systems sought to be protected. Applicant's claimed invention is clearly capable of avoiding such a situation.

With respect to independent Claims 33-35 and 39, applicant respectfully asserts that such claims are deemed allowable for, at least in part, the reasons set forth hereinabove with respect to the aforementioned independent claims.

Applicant also notes that the prior art is further deficient with respect to additional claim language in independent Claim 35. For example, the Examiner has relied on Figure 15 item 413 of Makita to make a prior art showing of applicant's claimed "scanning module coupled to the central processing unit and the storage subsystem controller, the scanning module adapted for identifying the requests from the central processing unit, and scanning the data for malicious code in response to the requests."

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Applicant respectfully asserts that item 413 of Figure 15 is a virus check unit to which "information to be recorded corresponding to the command is supplied" (see [0174] in Makita). Having information supplied to a virus check unit simply does not meet "scanning module adapted for identifying requests from the central processing unit," as claimed by applicant (emphasis added).

Further, the Examiner has relied on Makita's disclosed file management unit (Figure 15 item 211) and the following excerpts from Makita to make a prior art showing of applicant's claimed "event manager module coupled to the scanning module and the central processing unit, the event manager module adapted for receiving results of the scanning from the scanning module, the event manager module adapted to execute an event based on the results of the scanning":

"The file management unit 121 manages the storage of files into, the readout and deletion of files from, and access rights of the recording medium 4 of the external storage 120. The file management unit 121 includes programs for managing the recording medium 4 formatted into a desired logical format in formats corresponding to operation systems such as 12-bit FAT (File Allocation Table) of MS-DOS, the 16-bit FAT of MS-DOS, and UNIX." [0091]

"When a virus is discovered in step S8-5, a transmission to the host computer 110 is stopped, and the host computer 110 is notified that the virus is discovered (step S8-6)." [0183]

Applicant respectfully asserts that a file management unit that manages files, manages access to files, and manages the formatting of files along with stopping a transmission to the host computer when a virus is discovered as disclosed in Makita (see excerpts above) fails to meet "the event manager module adapted for receiving results of the scanning from the scanning module, the event manager module adapted to execute an event based on the results of the scanning," as claimed by applicant (emphasis added). Simply nowhere in Makita is there any suggestion of an "event manager module" that is "adapted for receiving results of the scanning" and "adapted to execute an event based on the results of the scanning," as claimed.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. A notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

The Examiner's rejections are also deficient with respect to the dependent claims, since the prior art relied upon by the Examiner fails to teach or suggest all of the claim limitations. For example, with respect to dependent Claim 40, the Examiner relies on Flint's disclosed "[t]he user or administrator also faces the challenges inherent in maintaining the external database" (Col. 2, lines 19-20) to make a prior art showing of applicant's claimed "wherein the user includes a remote administrator."

Applicant respectfully asserts that Flint's basic mention of an administrator that maintains an external database does not meet applicant's "user [that] includes a remote administrator" (Claim 40) in the context of applicant's claim language, such that the "user is allowed to disable the scanning module" (see independent Claim 1).

Again, a notice of allowance or a specific prior art showing of each of the foregoing limitations, in combination with the remaining claim elements, is respectfully requested.

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Reconsideration is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. Applicants are enclosing a check to pay for the added claims. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P020).

Respectfully submitted,

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